

**REMARKS**

This is in response to the Office Action mailed on November 29, 2005, in which claims 1-7, 9-14, 16, 29-34, 37-39, 41-45, 47 and 48 were rejected. Each claim was rejected in view of either Dorn, U.S. Patent No. 3,800,958 ("the Dorn '958 patent") or Duff, U.S. Patent No. 934,148 ("the Duff '148 patent"), or both as in the case of claim 1. With this Amendment, claims 1, 4, 29 and 37 are amended.

**I. Election/Restriction**

Claims 8, 15, 17-28, 35, 36, 40 and 46 were withdrawn from consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to a non-elected species, which is not dependent on an allowable generic or linking claim. However, the above listed claims all depend directly or indirectly on independent claims 1, 29 and 37, which have been amended to place them in condition for allowance, as discussed below. As such, under 37 C.F.R. § 1.142(b), Applicant respectfully requests that the withdrawn claims 8, 15, 17-28, 35, 36, 40 and 46 be reinstated and allowed.

**II. Claim Rejections under 35 U.S.C. § 102(b)**

Claims 1-7, 9-14, and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Dorn '958 patent. As amended, claim 1 requires that "the first vertical element at least partially defines a media holding region for receiving media" and that "no other horizontal element is connected to the first vertical element and extends into the media holding region, so that the media holding region is free of any horizontal element, including the first horizontal extension element."

The media holding device disclosed in the current application is configured such that the device, as well as the media that the device holds, both rest on a horizontal surface. In contrast, the Dorn '958 patent discloses a book rack where the media is supported by and sits on top of the horizontal portions of the book rack. As disclosed in the Dorn '958 patent, "[i]n addition to the connection between the end sections 11 provided by the side bar 10, the end sections are further connected by a plurality of rail bars 16 (here shown as two in FIGS. 1 and 2, and as three in FIG. 5) which extend longitudinally of the rack in laterally

spaced relation parallel to each other and to the side bar 10. The ends of these rails 16 underlie the end sections 11 and are fixedly attached thereto as by welding or other suitable means, *so that they provide a skeletal floor for the seating of books 17.*" (the Dorn '958 patent, col. 2, lines 54-64) (emphasis added). Moreover, the Dorn '958 patent further discloses "[i]n all forms of the invention, the side bar 10 constitutes a stop member against which edge portions of the bindings of books on the floor provided by rails 16 will rest, *so that no part of any book binding edge may come in contact with a surface on which the rack is seated.*" (the Dorn '958 patent, col. 3, lines 9-14) (emphasis added).

In the Office Action it was asserted that the first horizontal extension element in the Dorn '958 patent is element 20 and the first vertical element is element 18 (formed from a first rod and forming a first vertical plane). See Office Action 11/29/05 at p. 2, ¶ 4. In the Dorn '958 patent, two hooks 20 extend from each arm 19, as shown in FIGS. 1 and 2. Thus, if hook 20 positioned near side bar section 10 in FIG. 1 is a first horizontal extension element, then second hook 20 is also connected to the first vertical element (19). Thus, amended claim 1, requiring no other horizontal element connected to the first vertical element, is not anticipated by the Dorn '958 patent.

Moreover, in the Dorn '958 patent, the media holding region, defined between the pair of bookends 18, is not free of any horizontal element because rails 16 constitute horizontal elements included within the media holding region, as shown in FIG. 1. Since the Dorn '958 patent does not disclose, teach or suggest the use of a media holding region free of any horizontal element, amended claim 1 is further not anticipated by the Dorn '958 patent.

Dependent claim 4 has been amended, similar to claim 1, to state that "the second vertical element at least partially defines the media holding region" and that "no other horizontal element is connected to the second vertical element and extends into the media holding region, so that the media holding region is free of any horizontal element, including the second horizontal extension element."

Claims 2-7, 9-14 and 16 depend from claim 1 and contain all the limitations of claim 1. Since claim 1, as amended, is not anticipated by the Dorn '958 patent, claims 2-7, 9-14 and 16 are also not anticipated by the Dorn '958 patent.

Claims 1, 29, 31, 32 and 37-39 were rejected under 35 U.S.C. § 102(b) as being anticipated by the Duff '148 patent. As stated above, amended claim 1 requires that "the first vertical element at least partially defines a media holding region for receiving media" and that "no other horizontal element is connected to the first vertical element and extends into the media holding region, so that the media holding region is free of any horizontal element, including the first horizontal extension element." Independent claim 29 has been amended to require "a media holding region defined by the first and second uprights and the horizontal support, wherein the media holding region extends laterally between the first and second uprights and forward from the horizontal support, so that the horizontal support is positioned behind the media holding region and the media holding region is free of any horizontal element forward of the horizontal support." Independent claim 37 has been amended similarly to claim 29.

The Duff '148 patent, similar to the Dorn '958 patent, also discloses a book rack, where the media is supported by and sits on top of the horizontal portions of the book rack. The Duff '148 patent discloses "[a]s the books rest on the rods B and B', it is evident that the sections are not liable to slide accidentally out of the adjusted position, and hence the books are at all times held in proper position, that is, are practically clamped between the ends of the sections A and A'." (the Duff '148 patent, col. 2, lines 73-79)

In the Duff '148 patent, the media holding region is defined between sections A and A', and includes three horizontal extension elements (rods B and B') extending from a first vertical element (posts D and D'), as shown in FIG. 1. Thus, amended claim 1, which requires no other horizontal extension element connected to the first vertical element and extending into the media holding region, is not anticipated by the Duff '148 patent. Similarly, amended claims 29 and 37, which require that the horizontal support(s) is positioned behind the media holding region, are not anticipated by the Duff '148 patent.

The Duff device is configured such that the media rests *on* the horizontal extension elements B and B'. The Duff device is potentially capable of holding media on two of the three rods B and B'; thus, it is conceivable that one of the rods in the Duff device would be positioned behind the media holding region. However, in the Duff device, the media holding region always includes at least one support rod. The Duff '148 patent does not

disclose, teach or suggest the use of a media holding region that is free of any horizontal element, as required by amended independent claims 1, 29 and 37. As such, claims 1, 29 and 37, as amended, are further not anticipated by the Duff '148 patent.

Claims 31 and 32 depend from claim 29 and contain all the limitations of claim 29. Because claim 29 is not anticipated by the Duff '148 patent, claims 31 and 32 are also not anticipated by the Duff '148 patent.

Claims 38 and 39 depend from claim 37 and contain all the limitations of claim 37. Since claim 37 is not anticipated by the Duff '148 patent, claims 38 and 39 are also not anticipated by the Duff '148 patent.

### III. Claim Rejections under 35 U.S.C. § 103(a)

Claims 30, 33, 34, 41-45, 47, and 48 were rejected under 35 U.S.C. § 103(a) as being obvious over the Duff '148 patent. Claims 30, 33 and 34 depend from claim 29 and contain all the limitations of claim 29. As discussed above, claim 29, as amended, is patentable over the Duff '148 patent. Thus, claims 30, 33 and 34 are not obvious over the Duff '148 patent.

Claims 41-45, 47 and 48 depend from claim 37 and contain all the limitations of claim 37. As also discussed above, claim 37, as amended, is patentable over the Duff '148 patent; as such, claims 41-45, 47 and 48 are not obvious over the Duff '148 patent.

First Named Inventor: Keith L. Henk

Application No.: 10/628,669

-17-

**CONCLUSION**

Because the prior art made of record does not show, suggest, or teach all the limitations in claims 1-48, these claims are in condition for allowance. Favorable reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: 1/27/06

By: 

David R. Fairbairn, Reg. No. 26,047

THE KINNEY & LANGE BUILDING

312 South Third Street

Minneapolis, MN 55415-1002

Telephone: (612) 339-1863

Fax: (612) 339-6580

BRM:ANS:ks